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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			HANCE, ROBERT J	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/564,058	<b>Applicant(s)</b> KIKKOJI ET AL.	
	<b>Examiner</b> ROBERT HANCE	<b>Art Unit</b> 4134	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 January 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 27 and 28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26; 29-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 January 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>05/08/2006</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election without traverse of claims 1-26 and 29-30 in the reply filed on 06/16/2008 is acknowledged. Claims 27 and 28 are withdrawn from further consideration as being drawn to a nonelected invention.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The USPTO "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility" (Official Gazette notice of 22 November 2005), Annex IV, reads as follows:

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this context, "functional descriptive material" consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) "Nonfunctional descriptive material" includes but is not limited to music, literary works and a compilation or mere arrangement of data.

When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994) (claim to data structure stored on a computer readable medium that increases computer efficiency held statutory) and *Warmerdam*, 33 F.3d at 1360-61, 31 USPQ2d at 1759 (claim to computer having a specific data structure stored in memory held statutory product-by-process claim) with *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory).

In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. See *Lowry*, 32 F.3d at 1583-84, 32 USPQ2d at 1035.

Claims 29-30 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as follows. Claims 29-30 defines a program embodying functional descriptive material. However, the claim does not define a computer-readable medium or memory and is thus non-statutory for that reason (i.e., “When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized” – Guidelines Annex IV). That is, the scope of the presently claimed program can range from paper on which the program is written, to a program simply contemplated and memorized by a person.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 6 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. According to claim 6, a user purchases an arbitrary content and subsequently receives a first identification code: “. . . when a user who receives the broadcast program purchases an arbitrary content, the reception means receives a first identification code . . .” However, claim 6 goes on to state that the first identification code is transmitted by the user when the user wishes to purchase the arbitrary content: “. . . in response to an instruction to purchase the arbitrary content,

the transmission means transmits the first identification code together with purchase request information . . .” This limitation implies that the user has possession of the identification code before making the purchase request. Claims 6 and 16 will be examined under the assumption that the user possesses the identification code before the purchase request is made, as is consistent with claim 1 and the specification.

4. Claims 29-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 29 and 30 are vague because a program cannot comprise structural elements such as a transmission means and reception means.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 25 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gerszberg et al., US Patent No 6,178,446 in view of Paul et al., US Pub No 2003/0172108 and further in view of Garcia, US Patent No 5,510,832.

**As to claim 1** Gerszberg et al. disclose an information processing apparatus comprising: transmission means for transmitting request information, the request

information requesting related information related to a content in a broadcast program being received (Abstract; col. 8 line 59 – col. 9 line 9); reception means for receiving the related information corresponding to the request information, and an identification code indicative of a right to receive a particular service upon purchase of a content (col. 9 lines 35-58 – a subscriber receives related information and an electronic coupon. Since the coupon is electronic, it is an identification code, and coupons contain a right to receive a service upon purchase of content.); storage means for storing the identification code which has been received (col. 9 lines 52-56); and display means for displaying the related information (Fig. 9A: 422; Fig. 1: 10).

Gerszberg et al. fail to disclose that the request information is transmitted continuously at a particular interval. However, in an analogous art, Paul et al. disclose continuously transmitting additional data requests at a particular interval (Paragraph 42). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Gerszberg et al. with the teachings of Paul et al. by continuously transmitting additional data requests. The rationale for this modification would have been to continually request and receive updated information from the server. All the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

The combined system of Gerszberg and Paul fail to disclose storage means for storing the related information, and that the display means displays the related

information stored in the storage means. However, in an analogous art, Garcia discloses a system which receives data over a network, stores the data in a buffer, and subsequently displays the data (col. 10 line 66 to col. 11 line 6). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the combined system of Gerszberg and Paul with the teachings of Garcia by storing the received additional information in a buffer. The rationale for this modification would have been to buffer data as it is received, thus allowing for persistent display of the received information.

**As to claims 25 and 29** see similar rejection to claim 1. The method of claim 25 and the program of claim 29 correspond to the apparatus of claim 1. Therefore claims 25 and 29 have been analyzed and rejected.

7. Claims 2-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gerszberg et al. in view of Paul et al. in view of Garcia, as applied to claim 1 above, and further in view of Maritzen et al., US Pub No 2002/0026419.

**As to claim 2** the combined system of Gerszberg, Paul and Garcia fail to disclose the information processing apparatus according to claim 1, wherein the transmission means transmits the identification code together with purchase request information requesting purchase of a content, and the reception means receives content data corresponding to the purchase request information, as well as additional data corresponding to the identification code.

However, in an analogous art, Maritzen et al. disclose a system where television viewers can utilize a digital coupon to receive a discount on purchases, and that these coupons are "clipped" after a purchase (Paragraph 61).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the combined system of Gerszberg, Paul and Garcia with the teachings of Maritzen by transmitting coupons with purchase requests and subsequently receiving the purchased content as well as a clipped coupon (i.e. additional data corresponding to the identification code). The rationale for this modification would have been to enable viewers to instantly purchase items, receive a discount on those items, and to enable servers to "clip" the coupons for limited use during subsequent transactions. All the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

**As to claim 3** the combined system of Gerszberg, Paul and Garcia disclose the information processing apparatus according to claim 1, wherein the transmission means transmits user identification information to identify a user (Gerszberg col. 8 lines 33-36).

The combined system of Gerszberg, Paul and Garcia fail to disclose transmitting purchase request information requesting purchase of a content and the identification code. However, in an analogous art, Maritzen et al. disclose a system where television viewers can utilize a digital coupon to receive a discount on purchases, and that these coupons are "clipped" after a purchase (Paragraph 61).



8. Claims 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gerszberg et al. in view of Paul et al. in view of Garcia, as applied to claim 1 above, and further in view of Leonard et al., US Pub No 2002/0046109.

**As to claim 4** the combined system of Gerszberg, Paul and Garcia fails to disclose the information processing apparatus according to claim 1, wherein the reception means receives plural identification codes each being the identification code, and the transmission means transmits purchase request information requesting purchase of a content, and the plural identification codes.

However, in an analogous art, Leonard et al. disclose applying a plurality of e-coupons to a single purchase (Abstract).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the combined system of Gerszberg, Paul and Garcia with the teachings of Leonard et al. by receiving plural coupons from the server and transmitting these plural coupons with a purchase request. The rationale for this modification would have been to enable subscribers to benefit from larger discounts on purchases. All the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

**As to claim 5** the combined system of Gerszberg, Paul, Garcia and Leonard disclose the information processing apparatus according to claim 4, wherein the plural

identification codes transmitted by the transmission means are those that can be used for a purpose of purchase indicated by the purchase request information, among the plural identification codes received by the reception means (Leonard Abstract).

9. Claims 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gerszberg et al. in view of Paul et al. in view of Garcia, as applied to claim 1 above, and further in view of Maritzen et al., US Pub No 2002/0026419 in view of Giuliani et al., US Patent No 5,974,399.

**As to claim 6** the combined system of Gerszberg, Paul and Garcia disclose the information processing apparatus according to claim 1, wherein when a user who receives the broadcast program purchases an arbitrary content, the reception means receives a first identification code indicative of a right to allow the user to receive a particular service, the storage means stores the first identification code which has been received by the reception means (Gerszberg col. 9 lines 52-56), the display means displays the related information. (Gerszberg Abstract; col. 8 line 59 – col. 9 line 9; col. 9 lines 35-58 – a subscriber receives related information and a coupon).

Garcia discloses a system which receives data over a network, stores the data in a buffer, and subsequently displays the data (col. 10 line 66 to col. 11 line 6).

The combined system of Gerszberg, Paul and Garcia fails to disclose that, in response to an instruction to purchase the arbitrary content, the transmission means transmits the first identification code together with purchase request information

requesting purchase of the arbitrary content, and the reception means receives content data corresponding to the purchase request information.

However, in an analogous art, Maritzen et al. disclose a system where television viewers can utilize a digital coupon to receive a discount on purchases, and that these coupons are "clipped" after a purchase (Paragraph 61).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the combined system of Gerszberg Paul and Garcia with the teachings of Maritzen by transmitting coupons with purchase requests and subsequently receiving the purchased content as well as a clipped coupon (i.e. additional data corresponding to the identification code). The rationale for this modification would have been to enable viewers to instantly purchase items, receive a discount on those items, and to enable servers to "clip" the coupons for limited use during subsequent transactions.

The combined system of Gerszberg, Paul and Garcia and Maritzen fail to disclose that the reception means receives a second identification code indicative of a right to allow the user to receive a particular service when the user further purchases a content.

However, in an analogous art, Giuliani et al. disclose that receiving a coupon upon purchasing a particular item was known in the art at the time of the invention (col. 1 lines 29-35).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the combined system of Gerszberg, Paul, Garcia and Maritzen with

the teachings of Giuliani et al. by supplying a subscriber with a second coupon upon purchase of an item. The rationale for this modification would have been to entice a subscriber to make further purchases, possibly of related items.

**As to claim 7** the combined system of Gerszberg, Paul, Garcia, Maritzen and Giuliani disclose the information processing apparatus according to claim 6, wherein the reception means receives the content data, the second identification code, and additional data corresponding to the first identification code (Maritzen Paragraph 61 discloses a system where television viewers can utilize a digital coupon to receive a discount on purchases, and that these coupons are "clipped" after a purchase); receiving a second identification code (Giuliani et al. col. 1 lines 29-35).

**As to claim 8** the combined system of Gerszberg, Paul, Garcia, Maritzen and Giuliani disclose the information processing apparatus according to claim 6, wherein the transmission means transmits user identification information to identify the user. (Gerszberg col. 8 lines 33-36); the transmission means transmits the purchase request information and the first identification code (Maritzen Paragraph 61 – coupons are used to purchase content, thus coupons and purchase requests are transmitted).

10. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gerszberg, Paul, Garcia, Maritzen and Giuliani, as applied to claim 6 above, and further in view of Leonard et al., US Pub No 2002/0046109.

**As to claim 9** the combined system of Gerszberg, Paul, Garcia, Maritzen and Giuliani disclose the information processing apparatus according to claim 6, wherein the

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transmission means transmits the first identification codes, and the reception means receives the content data, the second identification code, and additional data corresponding to the first identification code (Maritzen Paragraph 61; Giuliani col. 1 lines 29-35).

The combined system of Gerszberg, Paul, Garcia, Maritzen and Giuliani fail to disclose a plurality of identification codes.

However, in an analogous art, Leonard et al. disclose applying a plurality of e-coupons to a single purchase (Abstract).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the combined system of Gerszberg, Paul, Garcia, Maritzen and Giuliani with the teachings of Leonard et al. by receiving plural coupons from the server, transmitting these plural coupons with a purchase request, and clipping these plural coupons. The rationale for this modification would have been to enable subscribers to benefit from larger discounts on purchases. All the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

11. Claims 10, 26 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gerszberg et al., US Patent No 6,178,446 in view of Paul et al., US Pub No 2003/0172108.

**As to claim 10** Gerszberg et al. disclose an information processing apparatus comprising: storage means for storing related information related to a content in a broadcast program received by a communication device (Fig. 6: 256; col. 8 lines 15-22); reception means for receiving request information requesting the related information from the communication device (Fig. 6: 254; col. 8 lines 15-33; col. 9 lines 10-52); and transmission means for transmitting the related information to the communication device in response to the request information received by the reception means (Fig. 6: 258; col. 9 lines 10-52), and transmitting an identification code indicative of a right to allow a user of the communication device to receive a particular service when the user purchases a content (col. 9 lines 50-55 – server sends users a coupon, i.e. an identification code indicative of a right to receive a particular service when the user purchases a content).

Gerszberg et al. fail to disclose that the request information is transmitted continuously at a particular interval.

However, in an analogous art, Paul et al. disclose continuously transmitting additional data requests at a particular interval (Paragraph 42).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Gerszberg et al. with the teachings of Paul et al. by continuously transmitting additional data requests. The rationale for this modification would have been to continually request and receive updated information from the server. All the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in

their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

**As to claims 26 and 30** see similar rejection to claim 10. The method of claim 26 and the program of claim 30 correspond to the apparatus of claim 10. Therefore claims 26 and 30 have been analyzed and rejected.

12. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gerszberg et al. in view of Paul et al., as applied to claim 10 above, and further in view of Pocock et al., US Patent No 5,014,125.

**As to claim 11** the combined system of Gerszberg and Paul fail to disclose the information processing apparatus according to claim 10, wherein the transmission means transmits one identical identification code as the identification code during a particular time band.

However, in an analogous art, Pocock et al. disclose transmitting coupons to viewers who are watching a particular commercial, where the coupon offers a discount on the product being advertised (col. 17 lines 3-14).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the combined system of Gerszberg and Paul with the teachings of Pocock et al. by providing coupons that relate to products being advertised, thus transmitting one identical coupon (i.e. identification code) during a particular time band (i.e. the time during which the commercial is being broadcast). The rationale for this modification would have been to provide users with relevant coupons in order to entice

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them to purchase the advertised product. All the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

13. Claims 12, 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gerszberg et al. in view of Paul et al., as applied to claim 10 above, and further in view of Maritzen et al., US Pub No 2002/0026419.

**As to claim 12** the combined system of Gerszberg and Paul disclose the information processing apparatus according to claim 10, wherein the reception means receives user identification information, from the communication device (Gerszberg col. 8 lines 33-36).

The combined system of Gerszberg and Paul fail to disclose that the apparatus receives purchase request information requesting purchase of a content and the identification code, and that the transmission means transmits content data corresponding to the purchase request information, and additional data corresponding to the identification code, to the communication device, and the information processing apparatus further comprises management means for managing transmission of the additional data by the transmission means, for every item of the user identification information.



However, in an analogous art, Maritzen et al. disclose a system where television viewers can utilize a digital coupon to receive a discount on purchases, that these coupons are "clipped" after a purchase, and that a server manages the clipping and transmission of individual viewer's coupons (i.e. for every item of the user identification information) (Paragraph 61).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the combined system of Gerszberg and Paul with the teachings of Maritzen by transmitting coupons with purchase requests and subsequently receiving the purchased content as well as a clipped coupon (i.e. additional data corresponding to the identification code), and to manage the clipping and transmission of the coupons on a server apparatus. The rationale for this modification would have been to enable viewers to instantly purchase items, receive a discount on those items, and to enable servers to "clip" the coupons for limited use during subsequent transactions

**As to claim 15** The combined system of Gerszberg Paul and Maritzen disclose that the transmission means transmits the additional data concerning the service provided by use of the service provider identification information (Maritzen Paragraph 61 - coupons are "clipped" after a purchase, i.e. supplied with additional data concerning the service provided by use of service provider information).

The combined system of Gerszberg Paul and Maritzen fail to disclose the information processing apparatus according to claim 12, wherein the identification code includes service provider identification information to identify a service provider who provides a particular service when the user purchases a content, and the transmission

means transmits the additional data concerning the service provided by use of the service provider identification information.

However, Examiner takes official notice of the fact that identification codes which include service provider identification information to identify a service provider who provides a particular service when the user purchases a content (in other words, a coupon which identifies the company and product for which the discount can be received) was well known in the art at the time of the invention.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the combined system of Gerszberg Paul and Maritzen by including service provider information that identifies a service provider who provides a particular service. The rationale for this modification would have been to allow a user to know where the coupon could be used, and for which products the discount could be received. All the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

14. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gerszberg et al. in view of Paul et al. in view of Maritzen et al., as applied to claim 12 above, and further in view of Leonard et al., US Pub No 2002/0046109.

**As to claim 13** the combined system of Gerszberg, Paul and Maritzen fail to disclose the information processing apparatus according to claim 12, wherein the

transmission means transmits the additional data, corresponding to the number of identification codes each being the identification code.

However, in an analogous art, Leonard et al. disclose applying a plurality of e-coupons to a single purchase (Abstract).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the combined system of Gerszberg, Paul and Maritzen with the teachings of Leonard et al. by receiving plural coupons from the server, transmitting these plural coupons with a purchase request, and to have the server clip each of the plurality of coupons, thus transmitting additional data corresponding to the number of coupons received. The rationale for this modification would have been to enable subscribers to benefit from larger discounts on purchases. All the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

15. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gerszberg et al. in view of Paul et al. in view of Maritzen et al., as applied to claim 12 above, and further in view of Holman, US Patent No 5,287,181.

**As to claim 14** the combined system of Gerszberg, Paul and Maritzen fail to disclose the information processing apparatus according to claim 12, wherein the identification code includes information indicative of an expiration limit, and the

transmission means transmits the additional data, corresponding to the identification code which has not expired yet.

However, in an analogous art, Holman discloses electronic coupons which contain expiration dates (fig. 5: 252 and 270; col. 14 lines 35-56).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the combined system of Gerszberg, Paul and Maritzen with the teachings of Holman by including expiration dates in the coupons. The rationale for this modification would have been to limit the time frames in which coupons can be used, thus making the promotion valid for a certain period only. All the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

the combined system of Gerszberg Paul, Maritzen and Holman fail to disclose that the transmission means transmits the additional data, corresponding to the identification code which has not expired yet.

However, examiner takes official notice of the fact that only transmitting coupons which have not yet expired was well known in the art at the time of the invention.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the combined system of Gerszberg Paul, Maritzen and Holman by only transmitting unexpired coupons. The rationale for this modification would have been to ensure that viewers only receive coupons which can be used. All the claimed

elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

16. Claims 16, 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gerszberg et al. in view of Paul et al., as applied to claim 10 above, and further in view of Maritzen et al., US Pub No 2002/0026419 in view of Giuliani et al., US Patent No 5,974,399.

**As to claim 16** the combined system of Gerszberg and Paul disclose the information processing apparatus according to claim 10, wherein when a user who receives the broadcast program purchases an arbitrary content, the transmission means transmits a first identification code indicative of a right to allow the user to receive a particular service together with the related information corresponding to the request information (Gerszberg Fig. 6: 258; col. 9 lines 10-52; col. 9 lines 50-55 – server sends users a coupon, i.e. an identification code indicative of a right to receive a particular service when the user purchases a content).

The combined system of Gerszberg and Paul fail to disclose that the reception means receives the first identification code together with purchase request information requesting purchase of the arbitrary content, and the transmission means transmits, together with content data corresponding to the purchase request information, a second

identification code indicative of a right to allow the user to receive a particular service when the user further purchase a content.

However, in an analogous art, Maritzen et al. disclose a system where television viewers can utilize a digital coupon to receive a discount on purchases, and that these coupons are "clipped" after a purchase (Paragraph 61).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the combined system of Gerszberg and Paul with the teachings of Maritzen by receiving coupons along with purchase requests, and sending the purchased content to the user. The rationale for this modification would have been to enable viewers to instantly purchase items for which they have seen advertisements and requested additional information.

The combined system of Gerszberg Paul and Maritzen fail to disclose that the transmission means transmits a second identification code indicative of a right to allow the user to receive a particular service when the user further purchase a content.

However, in an analogous art, Giuliani et al. disclose that receiving a coupon upon purchasing a particular item was known in the art at the time of the invention (col. 1 lines 29-35).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the combined system of Gerszberg Paul and Maritzen with the teachings of Giuliani et al. by supplying a subscriber with a second coupon upon purchase of an item. The rationale for this modification would have been to entice a subscriber to make further purchases, possibly of related items. All the claimed

elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

**As to claim 18** the combined system of Gerszberg, Paul, Maritzen and Giuliani disclose the information processing apparatus according to claim 16, wherein the reception means receives the user identification information to identify the user (Gerszberg col. 8 lines 33-36); and that the transmission means transmits the content data and additional data corresponding to the first identification code, and the information processing apparatus further comprises management means for managing transmission of the additional data by the transmission means, for every item of the user identification information (Maritzen Paragraph 61 discloses a system where television viewers can utilize a digital coupon to receive a discount on purchases, that these coupons are "clipped" after a purchase, and that a server manages the clipping and transmission of individual viewer's coupons (i.e. for every item of the user identification information) ).

17. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gerszberg, Paul, Maritzen and Giuliani, as applied to claim 16 above, and further in view of Pocock et al., US Patent No 5,014,125.

**As to claim 17** the combined system of Gerszberg, Paul, Maritzen and Giuliani fail to disclose the information processing apparatus according to claim 16, wherein the

transmission means transmits one identical first identification code as the first identification code during a particular time band.

However, in an analogous art, Pocock et al. disclose transmitting coupons to viewers who are watching a particular commercial, where the coupon offers a discount on the product being advertised (col. 17 lines 3-14).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the combined system of Gerszberg, Paul, Maritzen and Giuliani with the teachings of Pocock et al. by providing coupons that relate to products being advertised, thus transmitting one identical coupon (i.e. identification code) during a particular time band (i.e. the time during which the commercial is being broadcast). The rationale for this modification would have been to provide users with relevant coupons in order to entice them to purchase the advertised product. All the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

18. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gerszberg, Paul, Maritzen and Giuliani, as applied to claim 18 above, and further in view of Leonard et al., US Pub No 2002/0046109.

**As to claim 19** the combined system of Gerszberg, Paul, Maritzen and Giuliani fail to disclose the information processing apparatus according to claim 18, wherein the



transmission means transmits the additional data, corresponding to the number of first identification codes each being the first identification code.

However, in an analogous art, Leonard et al. disclose applying a plurality of e-coupons to a single purchase (Abstract).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the combined system of Gerszberg, Paul, Maritzen and Giuliani with the teachings of Leonard et al. by receiving plural coupons from the user with a purchase request and to clip each of the plurality of coupons, thus transmitting additional data corresponding to the number of coupons received. The rationale for this modification would have been to enable subscribers to benefit from larger discounts on purchases.

19. Claims 20, 21 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gerszberg, Paul, Maritzen and Giuliani, as applied to claim 16 above, and further in view of Holman, US Patent No 5,287,181.

**As to claim 20** the combined system of Gerszberg, Paul, Maritzen and Giuliani fails to disclose the information processing apparatus according to claim 16, wherein the first identification code includes information indicative of an expiration limit.

However, in an analogous art, Holman discloses electronic coupons which contain expiration dates (fig. 5: 252 and 270; col. 14 lines 35-56).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the combined system of Gerszberg, Paul, Maritzen and Giuliani with

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the teachings of Holman by including expiration dates in the coupons. The rationale for this modification would have been to limit the time frames in which coupons can be used, thus making the promotion valid for a certain period only. All the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

**As to claim 21** the combined system of Gerszberg, Paul, Maritzen and Giuliani fail to disclose the information processing apparatus according to claim 16, wherein the first identification code includes service provider identification information to identify a service provider who provides a particular service when the user purchases a content.

However, Examiner takes official notice of the fact that identification codes which include service provider identification information to identify a service provider who provides a particular service when the user purchases a content (in other words, a coupon which identifies the company and product for which the discount can be received) was well known in the art at the time of the invention.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify combined system of Gerszberg, Paul, Maritzen and Giuliani by including service provider information that identifies a service provider who provides a particular service. The rationale for this modification would have been to allow a user to know where the coupon could be used, and for which products the discount could be received.

**As to claim 23** combined system of Gerszberg, Paul, Maritzen and Giuliani fail to disclose the information processing apparatus according to claim 21, wherein the second identification code includes service provider identification information different from the service provider identification information.

However, Examiner takes official notice of the fact that it would have been obvious to one of ordinary skill in the art at the time of the invention that this second coupon could be for another product, from another service provider, and thus would have service provider identification information that is different from the first identification code.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify combined system of Gerszberg, Paul, Maritzen and Giuliani by having the second identification code (coupon) be for another service provider. The rationale for this modification would have been to allow for vendors to offer discounts on a wide variety of products, instead of only those products from a single service provider.

20. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gerszberg, Paul, Maritzen and Giuliani, as applied to claim 21 above, and further in view of Von Kohorn, US Patent No 5,128,752.

**As to claim 22** the combined system of Gerszberg, Paul, Maritzen and Giuliani fail to disclose the information processing apparatus according to claim 21, wherein the first identification code is authenticated based on the service provider identification information.

However, in an analogous art, Von Kohorn discloses authenticating coupons based on redemption information contained therein (claim 11).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the combined system of Gerszberg, Paul, Maritzen and Giuliani with the teachings of Von Kohorn by authenticating the coupons based on service provider identification information (which is a type of coupon redemption information). The rationale for this modification would have been to ensure that coupons are not forged. All the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

21. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gerszberg, Paul, Maritzen and Giuliani, as applied to claim 16 above, and further in view of Maeda, US Pub No 20030003431.

**As to claim 24** the combined system of Gerszberg, Paul, Maritzen and Giuliani fail to disclose the information processing apparatus according to claim 16, wherein the second identification code is a dummy track.

However, Maeda discloses storing data in a music track (i.e. a dummy track) (Paragraph 104).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the combined system of Gerszberg, Paul, Maritzen and Giuliani with

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the teachings of Maeda by storing coupon information in a dummy track. The rationale for this modification would have been to place the coupons in an existing data file (i.e. a music track). All the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT HANCE whose telephone number is (571)270-5319. The examiner can normally be reached on M-F 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Grant can be reached on (571)272-7294. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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